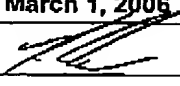



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 70651/7293	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 1, 2006</u> Signature <u></u> Typed or printed name <u>Kurt M. Eaton</u>		Application Number 09/864,093 Filed May 21, 2001 First Named Inventor Clark et al. Art Unit 2638 Examiner Hanh Phan	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>51,640</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">  Signature Kurt M. Eaton Typed or printed name (858) 552-1311 Telephone number March 1, 2006 Date </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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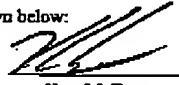
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Docket No. 70651/7293

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/864,093	<u>Certificate of Transmission/Mailing</u>
Applicants:	Gerald R. Clark, et al.	I hereby certify that this correspondence is being facsimile transmitted to the:
Filed:	May 21, 2001	USPTO
Title:	FREE-SPACE OPTICAL COMMUNICATION SYSTEM EMPLOYING WAVELENGTH CONVERSION	Fax No.: (571) 273-8300
Examiner:	Hanh Phan	or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
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		March 1, 2006 
		Date Kurt M. Eaton
		Registration No. 51,640
		Attorney for Applicant(s)

BRIEF IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Advisory Action mailed February 2, 2006, please enter the following brief in support of the attached Pre-Appeal Request for Review. A Notice of Appeal is also submitted herewith.

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Brief in Support of Pre-Appeal Request for Review

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REMARKS

Claims 1 and 12 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Medved et al. (U.S. Patent No. 5,818,619), claims 2-7, 10, 11, 13-17, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Medved et al. in view of Geiger (U.S. Patent No. 5,377,219), claims 8 and 18 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Medved et al. in view of Kumar et al. (U.S. Patent App. Pub. No. 2002/0075542), claims 22, 28, 29, 34, 35, 42, 43 and 50 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Medved et al. in view of Ransford et al. (U.S. Patent No. 6,532,087), claims 23-25, 30-32, 36-39, 44-47 and 49 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Medved et al. in view of Ransford et al. and further in view of Geiger, and claims 26, 27, 33, 40, 41 and 48 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Medved et al. in view of Ransford et al. and Geiger and further in view of Kumar et al.

In their response filed November 9, 2005, Applicants amended independent claims 1, 12, 22, 29, 35, and 43 to incorporate subject matter from respective dependent claims that was previously considered in the Final Office Action mailed September 9, 2005. Specifically, independent claim 1 was amended to recite the elements found in dependent claims 2 and 3, independent claim 12 was amended to recite the elements found in dependent claims 13 and 14, and independent claims 22, 29, 35, and 43 were amended to recite the elements found in dependent claims 23, 30, 36, and 44, respectively. New arguments supporting the nonobviousness of the subject matter recited in the aforementioned dependent claims were also presented in Applicants' response filed November 9, 2005. As indicated in the Advisory Action mailed February 2, 2006, the amendments to claims 1, 12, 22, 29, 35, and 43 were not entered and Applicants' new arguments were considered but were not deemed to place the application in condition for allowance. Accordingly, the Advisory Action maintained the rejections of the Final Office Action mailed September 9, 2005.

- I. The Advisory Action clearly errs in maintaining the rejections of claims 2, 3, 13, 14, 23, 30, 36, and 44 because the Examiner has failed to answer the substance of Applicants' arguments.**

In the Advisory Action, the Examiner asserts that Applicants traversed the rejections of the Final Office Action by arguing that:

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"the cited references (Medved et al and Geiger) fail to teach [wherein the step of converting the fiber interface fundamental wavelength of the first optical signal to a free space fundamental wavelength is performed all-optically without using electro-optical conversion, and wherein the step of converting the free space fundamental wavelength of the second optical signal to a fiber interface fundamental wavelength is performed all-optically without using electro-optical conversion]."

It is respectfully submitted, however, that no such argument was advanced by Applicants. Rather, Applicants response filed November 9, 2005 established that the subject matter of dependent claims 2 and 3 is not rendered obvious by the combination of Medved et al. in view of Geiger because there is no proper motivation to modify Medved et al. using Geiger as suggested in the final Office Action. (see II. below and Applicants' response filed November 9, 2005; page 16, line 9 – page 17, line 15). The arguments presented with respect to the subject matter of dependent claims 2 and 3 are equally applicable to the subject matter of dependent claims 13, 14, 23, 30, 36, and 44.

As set forth at M.P.E.P. § 707.07(f), "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Because the rejections of the Final Office Action were maintained in the Advisory Action based on an allegedly unpersuasive but fictitious argument, the Examiner failed to take note of and answer the substance of Applicants' arguments as actually presented in their response filed November 9, 2005 and, therefore, clearly erred in maintaining the finality of the rejections of the subject matter in claims 2, 3, 13, 14, 23, 30, 36, and 44.

II. The rejections of the Final Office Action of claims 2, 3, 13, 14, 23, 30, 36, and 44 clearly err in proposing that Medved et al. be modified with Geiger because the proposed modification of Medved et al. would render Medved et al. unsatisfactory for its intended purpose and completely change its principle of operation, which means there is no motivation for the proposed modification.

The Examiner asserts that it would be obvious in view of Geiger to modify the system of Medved et al. to operate all-optically. Applicants strongly disagree. This is because Medved et al. relies heavily on the properties of photodiodes which would not be present in an all-optical system.

Specifically, Medved et al. teach that the universal converter unit 10 disclosed

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therein "must be able to transfer optical data to and from communication networks at both ranges of 800-900 and 1300 nanometers" (col. 4, lines 61-63). In order to enable this universality, Medved et al. rely on the spectral responsivity of silicon and InGaAs photodiodes and emitting power of LEDs as shown in FIG. 2. Thus, the principle by which the system of Medved et al. operates is completely based upon electro-optical conversion.

If the RXU 24, airlink transmitter 26, TXU 20, and airlink receiver 21 of Medved et al. were eliminated and replaced by all-optical components as presumably suggested by the Examiner, the principle of operation by which the system of Medved et al. operates would be radically changed, resulting in FIG. 2 of Medved et al. becoming irrelevant. Furthermore, the intended universality of the universal converter unit 10 would be completely destroyed because the InGaAs photodiodes would no longer be present to automatically detect a wide range of wavelengths. Again, Medved et al. relies heavily on the properties of photodiodes which would not be present in an all-optical system. Applicants assert that the proposed all-optical replacement components would be tuned to a specific, much smaller range of wavelengths than that disclosed in Medved et al. and would function in a completely different manner that does not achieve the desired universality described in Medved et al.

Therefore, Applicants assert that a person of ordinary skill in the art would have no motivation whatsoever to modify the system of Medved et al. to operate all-optically, without electro-optical conversion, because to do so would completely change its principle of operation and render the system unsatisfactory for its intended purpose of universality. As such, a *prima facie* case of obviousness of the subject matter of claims 2, 3, 13, 14, 23, 30, 36, and 44 cannot be based on such a modification of Medved et al.

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CONCLUSION

Applicants submit that the above amendment and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,



Dated: March 1, 2006

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